

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Thomas) Examiner:	Sheikh, Asfand M.
)	
Application No.:	10/584,417) Attny Doc.:	31083.10US2
)	
Filing Date:	June 23, 2006) Art Unit:	3627
)	
Title:	System And Method For)	
	Managing The Delivery Of)	
	Order For Goods)	

APPEAL BRIEF

FILED VIA EFS-Web

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellant hereby submits this Appeal Brief in connection with the appeal to the Board of Patent Appeals and Interferences of the Examiner's continued rejection of claims 1, 4, 5, 10, 11, 13-21, 42, and 43.

A Notice of Appeal was filed in connection with a Request For Pre-Appeal Review.

This Appeal Brief is being filed electronically via EFS-Web.

The Commissioner is hereby authorized to charge any fee deficiency to deposit account number 50-2428 in the name of Greenberg Traurig.

Certificate of Electronic Transmission: I hereby certify that this document and its attachments are being electronically transmitted to the U.S. Patent and Trademark Office via EFS-Web on this 12th day of March, 2012.

/Gladys Munoz/
Gladys Munoz

I. Real Party In Interest

The real party in interest is W.W. Grainger, Inc.

II. Related Appeals And Interferences

Appellant does not believe that there are any appeals, interferences, or judicial proceedings which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the subject appeal.

III. Status Of The Claims

In the application claims 1, 4, 5, 10, 11, 13-21, 42, and 43 remain pending and are the subject of this appeal.

Claims 2, 3, 6-9, 12, and 22-41 have been cancelled without prejudice..

The Section VIII appendix provides a clean, double spaced copy of pending claims 1, 4, 5, 10, 11, 13-21, 42, and 43 .

IV. Status Of Amendments

The claims are in condition for appeal.

No amendments to the claims are currently pending.

V. Summary Of The Claimed Subject Matter

In accordance with 37 CFR § 41.37(c)(1)(v), the following provides a concise explanation of the subject matter defined in the independent claim that is involved in the appeal with reference, by way of example only, to the specification by page and line numbers and drawing elements as applicable:

Independent claim 1 is directed to a system for facilitating and controlling route-based

delivery of an orders for goods from a central servicing warehouse to a remote ship-to sites, comprising:

one or more self-service drop-off containers located at the remote ship-to site [See, e.g., Pg. 4, line 27-Pg. 5, line 6 and Pg. 6, line 34-Pg. 7, line 23];

an inventory control system associated with the one or more drop-off containers [See, e.g., Pg. 6, line 15-Pg. 8, line 13].;

a manifesting system in communication with the inventory control system, the manifesting system implementing a manifesting process to manage and document the location and status of the order for goods, associated inventory of goods in the central servicing warehouse, and the hand-off at the remote ship-to site of custody of the order for goods between parties involved in the process via a deposit of the order for goods into the one or more self-service drop-off containers located at the remote ship-to site [See, e.g., Pg. 5, line 20-Pg. 6, line 8]; and

a security monitoring system [See, e.g., Pg. 7, line 30-Pg. 8, line 13];

wherein the manifesting system further identifies and compiles into a draft manifest a logical grouping of all outstanding orders to be transported to ship-to sites on a specific route; converts the draft manifest to a committed manifest, where the committed manifest becomes the official, permanent record of the order for goods consigned to a delivery vehicle on that specific route, when it is determined that the draft manifest record accurately reflects the order for goods to be loaded on the delivery vehicle; and communicates the committed manifest to the inventory control system [See, e.g., Pg. 6, line 23-Pg. 7, line 14] ;

wherein the inventory control system logically checks off each good in the order for goods when the order for goods is deposited into the one or more self-service drop-off containers

against a list of goods as indicated by the committed manifest and determines whether any goods within the order for goods are either not expected or missing and, when it is determine that any goods within the order for goods are either not expected or missing, automatically generates and sends a communication alert to the security monitoring system [See, e.g., Pg. 6, line 15-Pg. 8, line 13].

VI. Grounds Of Rejection To Be Reviewed On Appeal

In the Office Action of October 11, 2011 (“OA”):

a) claims 1, 4, 5, 10, 20, 21, 42, and 43 were rejected under 35 U.S.C. § 103 as being unpatentable over DeMaggio (US Patent No. 7,292,989) in view of Applicant’s Admitted Prior Art and Kahn (US Patent No. 7,395,273); and

b) claims 11 and 13-19 were rejected under 35 U.S.C. § 103 as being unpatentable over DeMaggio (US Patent No. 7,292,989) in view of Applicant’s Admitted Prior Art and Kahn (US Patent No. 7,395,273) and Official Notice.

Appellant hereby requests review of the rejection under 35 U.S.C. § 103 of independent claim 1.

Appellant is not seeking review of the rejection under 35 U.S.C. § 103 of dependent claims 4, 5, 10, 11, 13-21, 42, and 43.

VII. Argument

A) The Applicable Law

It is respectfully submitted that a rejection under 35 U.S.C. § 103 can be maintained only if it has been demonstrated that all of the claimed elements were expressly or inherently

described in the prior art and that one skilled in the art could have combined such described elements by known methods with no change in their respective functions with the combination yielding nothing more than predictable results. *KSR v. Teleflex*, 550 U.S. 398 (2007); *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950).

B) The Rejection of Independent Claim 1

i) Summary of the Rejection of Claim 1 Under 35 U.S.C. § 103

In the rejection of independent claim 1 and 9, it was asserted that DeMaggio discloses:

a) a system for facilitating and controlling route-based delivery of an order[s] for goods from a central servicing warehouse to a remote ship-to-site[s] (citing to Col. 1, line 59-Col. 2, line 31);

b) a manifesting system in communication with the inventory control system (citing to Col. 5, line 46-Col. 6, line 28 and Col. 8, lines 24-61);

c) a manifesting system implementing a manifesting process to manage and document the location and status of the orders for goods, associated inventory of goods in the central servicing warehouse, and the hand-off at the remote ship-to-site of custody of the order for goods between parties involved in the process (citing to Col. 1, line 59-Col. 2, line 50 and Col. 7, lines 65-67);

d) a security monitoring system (no citation provided);

e) the manifesting system identifies and compiles into a draft manifest a logical grouping of all outstanding orders to be transported to ship-to-sites on a specific route (citing to Col. 2, lines 31-50 and Col. 5, line 46-Col. 6, line 28);

f) the manifesting system converts the draft manifest to a committed manifest, where the committed manifest becomes the official, permanent record of the orders for goods consigned to the truck for that run of that specific route, when it is determined that the draft manifest record accurately reflects the order for goods to be loaded on the truck (citing to Col. 5, line 46-Col. 6, line 28 and Col. 10, lines 5-58);

g) the manifesting system communicates the committed manifest to the inventory control system (citing to Col. 5, line 46-Col. 6, line 28);

h) the inventory control system logically checks off each good in the order for goods, against a list of orders for goods it is expecting as indicated by the committed manifest (citing to Col. 5, line 46-Col. 6, line 15); and

i) the inventory control system automatically generates and sends a communication alert to the security monitoring system (citing to Col. 6, lines 16-28).

It was then acknowledged that DeMaggio fails to disclose:

- a) one or more self-service drop-off containers located at a remote ship-to site;
- b) an inventory control system associated with the one or more drop-off containers;
- c) depositing an order for goods into one or more self-service drop-off containers;
- d) an inventory control system that logically checks off each good in the order for goods when the order for goods is deposited into the one or more self-service drop-off containers;
- e) determining whether any goods within the order for goods are either not expected or missing; and

f) when it is determined that any goods within the order for goods are either not expected or missing, automatically generating and sending a communication alert to a security monitoring system.

It was then asserted that Applicant's Admitted Prior Art discloses:

- a) one or more self-service drop-off containers located at the remote ship-to site;
- b) an inventory control system associated with the one or more drop-off containers;
- c) depositing an order for goods into one or more self-service drop-off containers; and
- d) an inventory control system that logically checks off each good in the order for goods when the order for goods is deposited into the one or more self-service drop-off containers.

It was therefore concluded that it would have been obvious to modify the teachings of DeMaggio to include: a) one or more self-service drop-off containers located at the remote ship-to site; b) an inventory control system associated with the one or more drop-off containers; c) depositing an order for goods into one or more self-service drop-off containers; and d) an inventory control system that logically checks off each good in the order for goods when the order for goods is deposited into the one or more self-service drop-off containers "in order to deliver goods to customers at remote locations."

It was further asserted that Kahn discloses:

- a) determining whether any goods within the order for goods are either not expected or missing; and
- b) when it is determined that any goods within the order for goods are either not expected or missing, automatically generating and sending a communication alert to a security monitoring system (citing to Col. 7, lines 26-57).

It was therefore concluded that it would have been obvious to modify the teachings of DeMaggio to include a) determining whether any goods within the order for goods are either not expected or missing; and b) when it is determined that any goods within the order for goods are either not expected or missing, automatically generating and sending a communication alert to a

security monitoring system “in order to provide receipt inspection reporting and tracking.”

iii) Argument With Respect to the 103 Rejection of Claim 1

In the rejection of the claims, it was acknowledged that DeMaggio does not disclose, teach, or suggest one or more self-service drop-off containers having an associated inventory control system where the inventory control system logically checks off each good in an order for goods when the order for goods is deposited into the one or more self-service drop-off containers against a list of goods as indicated by a committed manifest. It was, however, asserted that these claimed elements are disclosed in Applicant’s Admitted Prior Art.

In response, it is respectfully submitted that the “Background” section of the subject application does not disclose or describe one or more self-service drop-off containers having an associated inventory control system *where the inventory control system logically checks off each good in an order for goods when the order for goods is deposited into the one or more self-service drop-off containers.*

In the “Background” section of the subject application, it is only stated that “[a] further system for monitoring inventory of storage units, such as mailboxes, bins, and shelves, is described in published U.S. Application No. 2003/0052778.”

It is respectfully submitted that this statement never *admits* that an inventory control system that logically checks off each good in an order for goods when the order for goods is deposited into one or more self-service drop off containers is known or otherwise found in the prior art as asserted and relied upon in rejecting the claims at issue.

It is also respectfully submitted that a system for monitoring inventory of storage units, such as mailboxes, bins, and shelves need not “require a form of logically checking [off]...” as

relied upon in rejecting the claims at issue. (OA; pg. 2). In this regard, it is respectfully submitted that the Office has presented no evidence to demonstrate how a system that merely monitors would require “checking off” as is mandated by the burdens associated with presenting a *prima facie* case of obviousness.

That a system for monitoring inventory of storage units, such as mailboxes, bins, and shelves does not “require a form of logically checking [off]...” is evidenced by U.S. Application No. 2003/0052778 (“Wong”) that is cited to in the “Background” section of the subject application, i.e., the Applicant’s Admitted Prior Art. In this regard, when Wong is actually considered, instead of disclosing, teaching, or suggesting an inventory control system that receives a committed manifest and which then functions to *check off each good in an order for goods* as reflected in the committed manifest when the order for goods is deposited into one or more self-service drop off containers, Wong discloses a system wherein sensors report to a computer that *something*, e.g. some piece of mail or some article, was placed into [or removed from] a mailbox or the like and the computer then functions to notify a user, e.g., via email, phone, etc., to the fact that *something* was placed into [or removed from] the mailbox or the like at a given time. (Paras. 0094-0106 and 0110). That Wong does not “require” a form of logically checking off is particularly evidenced by the fact that the system of Wong does not receive any manifest or the like which sets forth items that can be compared to, i.e., checked off against, items that are to be sensed as being placed [or not being placed] into a mailbox or the like.

In summary, because Wong itself evidences that, to one or ordinary skill in the art, a system that simply monitors a storage unit does not and need not “require” a form of logically checking off each good in an order for goods, let alone against a listing of items in a committed manifest *when the order for goods is deposited into* a self-service drop off container as claimed,

it is respectfully submitted that the Applicant's Admitted Prior Art cannot be said to expressly or inherently disclose the claimed elements that have been acknowledged to be missing from DMaggio in the first instance. For at least this reason, namely, that the prior art does not disclose all of the elements claimed, it is respectfully submitted that a *prima facie* case of obviousness has not been presented and the rejection of the claims under 35 U.S.C. § 103 must be withdrawn.

It is additionally respectfully submitted that, while Kahn discloses a system that generally provides for receipt inspection reporting, contrary to the assertion made in the Office Action Kahn does not disclose, teach, or suggest an inventory control system automatically generating and sending a communication alert to a security monitoring system when it is determined that too few expected or unexpected goods are included within the received order for goods. Rather than describe anything *automatically generating* and *sending a communication alert*, particularly to a security monitoring system in response to it being determined that too few expected or unexpected goods are included within a received order for goods, cited to Col. 7, lines 26-57 of Kahn only describes *storing* receipt inspection reporting data in a database to thereby allow the receipt inspection data to be reviewed and manually approved before being reported to a party. Thus, because Kahn fails to disclose these claimed elements that have been acknowledged to be missing from DeMaggio in the first instance, it is respectfully submitted that the rejection of the claims fails to present a *prima facie* case of obviousness and the rejection under 35 U.S.C. § 103 must be withdrawn.

Respectfully Submitted;

Date: March 12, 2012

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VIII. Claims Appendix

The following is a clean copy of the claims involved in the appeal:

Listing of Claims:

1. A system for facilitating and controlling route-based delivery of an orders for goods from a central servicing warehouse to a remote ship-to sites, comprising:

one or more self-service drop-off containers located at the remote ship-to site;

an inventory control system associated with the one or more drop-off containers;

a manifesting system in communication with the inventory control system, the manifesting system implementing a manifesting process to manage and document the location and status of the order for goods, associated inventory of goods in the central servicing warehouse, and the hand-off at the remote ship-to site of custody of the order for goods between parties involved in the process via a deposit of the order for goods into the one or more self-service drop-off containers located at the remote ship-to site; and

a security monitoring system;

wherein the manifesting system further identifies and compiles into a draft manifest a logical grouping of all outstanding orders to be transported to ship-to sites on a specific route; converts the draft manifest to a committed manifest, where the committed manifest becomes the official, permanent record of the order for goods consigned to a delivery vehicle on that specific route, when it is determined that the draft manifest record accurately reflects the order for goods to be loaded on the delivery vehicle; and communicates the committed manifest to the inventory control system;

wherein the inventory control system logically checks off each good in the order for

goods when the order for goods is deposited into the one or more self-service drop-off containers against a list of goods as indicated by the committed manifest and determines whether any goods within the order for goods are either not expected or missing and, when it is determine that any goods within the order for goods are either not expected or missing, automatically generates and sends a communication alert to the security monitoring system.

4. The system as recited in claim 1, wherein the manifesting system posts the committed manifest into an order management system of a vendor of the goods to update records to reflect that the orders for goods have left the central servicing warehouse and are on route to the remote ship-to sites.

5. The system as recited in claim 1, wherein the manifesting system posts the committed manifest into an inventory management system of a vendor of the goods to reflect that the orders for goods is now under the control of a driver of the delivery vehicle.

10. The system as recited in claim 1, wherein the inventory control system transmits delivery results to the manifesting system so that inventory records of the manifesting system may be updated to reflect that the orders for goods have been received at the ship-to site and are available for pick up by a customer from the one or more self-service drop-off containers.

11. The system as recited in claim 1, wherein the one or more self-service drop-off containers requires a customer to identify themselves appropriately using a previously determined PIN or ORN in order to be allowed access to goods within the an order for goods.

13. The system as recited in claim 1, wherein the inventory control system reports back to the manifesting system an acceptance and removal of a good within the order for goods from the one or more self-service, drop-off containers to the manifesting system so that order status and inventory records maintained by the manifesting system may be updated.

14. The system as recited in claim 13, wherein the manifesting system causes billing of a customer in response to receiving a notification of the acceptance and removal of the good within the order for goods from the one or more self-service, drop-off containers by the customer.

15. The system as recited in claim 13, wherein the manifesting system causes a debiting of a customer account in response to receiving a notification of the acceptance and removal of the good within the order for goods from the one or more self-service, drop-off containers by a customer.

16. The system as recited in claim 1, wherein the inventory control system of a ship-to site initiates a goods return process for rejected orders, returned goods, abandoned deliveries, or empty containers by creating a to-be-returned reverse logistics order in the manifesting system which functions to notify a vendor to expect goods for receipt back at the central servicing warehouse.

17. The system as recited in claim 16, wherein the manifesting system responds to a to-be-

returned logistics order by scheduling a driver to pick up the goods to be returned on a next visit to the ship-to site.

18. The system as recited in claim 17, wherein the inventory control system records a time of pickup of goods to be returned and notifies the manifesting system of the time.

19. The system as recited in claim 18, wherein receipt of goods to be returned is confirmed by the central servicing warehouse and entered into the manifesting system.

20. The system as recited in claim 1, wherein the manifesting system facilitates and controls route-based delivery of orders for goods by using an order cut-off time for all the ship-to sites on a specific delivery routes whereby customers will know a time by which to place an order for goods to ensure delivery at their chosen ship-to site within a given time frame.

21. The system as recited in claim 20, where the draft manifest is generated automatically in response to attaining the cut-off time for that route.

42. The system as recited in claim 1, wherein the one or more self-service drop-off containers comprise a vending machine.

43. The system as recited in claim 1, wherein the one or more self-service drop-off containers comprises a will-call locker.

IX. Evidence Appendix

No evidence is being submitted herewith.

X. Related Proceedings Appendix

No decisions are being submitted herewith.

CHI 62,174,853v1